

Mark: RAINBOW SET
Serial No.: 86/668636
Our Reference: MASIMOT.652T

The following remarks are submitted in response to the Office Action issued on September 27, 2015.

IDENTIFICATION OF GOODS

Applicant requests that the identification of goods in the application be amended to read as follows:

Class 10: Medical devices, namely, patient monitors and patient sensors for monitoring and measuring blood properties, tissue properties, pulse rate, brain function or respiratory properties

“SET” IS APPLICANT’S DISTINCTIVE TRADEMARK WHICH IS THE SUBJECT OF INCONTESTABLE U.S. REGISTRATION NO. 1941315

The Examining Attorney has requested that Applicant, Masimo, disclaim “set” in the RAINBOW SET mark. The Examining Attorney suggests that “set” is a merely descriptive mark in that it describes an ingredient, quality, characteristic, function, feature, purpose, or use of Applicant’s goods, and thus, is an unregistrable component of the mark. The SET portion of Applicant’s mark, however, is Masimo’s distinctive and well-known SET® trademark which is the subject of U.S. Registration No. 1941315. A copy of the registration is attached as Exhibit A. The goods in the registration are as follows: “electronic sensors and monitors for extracting signals from data containing noise” in Class 9 and “in vivo patient monitors and sensors for detecting a physiological condition” in Class 10.

Applicant’s SET® registration issued on the Principal Register in 1995. This registration is incontestable. Applicant’s SET® mark was adopted over two decades ago and is a distinctive and well-known trademark associated with Applicant’s goods. Because SET® is a distinctive registered trademark and not merely a descriptive term, a disclaimer of SET is not required.

Applicant also notes that SET does not have any significance in the medical monitor or sensor field or as applied to the goods described in the application other than that it signifies Applicant’s well-known SET® mark and the associated goodwill Applicant has

accumulated from its extensive use and promotion of SET® since at least as early as 1994. Likewise, SET is not a “term of art” within Applicant’s industry. In sum, the mark RAINBOW SET is a distinctive mark.

INFORMATION ABOUT MASIMO’S GOODS

The RAINBOW SET goods are patient monitors and sensors. The sensors are placed on the fingers or the feet of patients and help measure and monitor vital signs and provide other patient data to help a clinician monitor a patient’s care. Attached hereto as Exhibit B is a copy of Masimo’s website showing the sale of similar goods, namely, patient monitors and sensors, under a different mark.

CONCLUSION

Applicant submits that it has responded to all outstanding issues raised in the Office Action. Applicant respectfully requests the Examining Attorney to pass the application for publication. Should the Examining Attorney have any questions, the Examining Attorney is encouraged to contact the undersigned.